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EXAMINER	
BELIVEAU, SCOTT E	

ART UNIT	PAPER NUMBER
2623	

NOTIFICATION DATE	DELIVERY MODE
05/10/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	09/545,015	HABERMAN ET AL.	
	Examiner	Art Unit	
	Scott Beliveau	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 April 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 and 3-13* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1 and 3-13* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *4/17/07*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 17 April 2007 has been entered.

Response to Amendment

2. The declaration filed on 17 April 2007 under 37 CFR 1.131 has been considered but is ineffective to overcome the Ficco reference because the evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the Ficco reference.

Applicants assert that Exhibit A alongside the declaration provide evidence that the invention defined in claims 1 and 3-13 was conceived and actually reduced to practice at least prior to 23 March 2000 (i.e., the filling date of Ficco). The examiner respectfully disagrees as the proof of actual reduction to practice does not provide a showing that the apparatus actually existed and that it worked for its intended purpose.

" . . . A party seeking to establish an actual reduction to practice must satisfy a two-prong test: (1) the party constructed an embodiment or performed a process that met every element of the interference count, and (2) the embodiment or process operated for its intended purpose." Eaton v. Evans, 204 F.3d 1094, 1097, 53 USPQ2d 1696, 1698 (Fed. Cir. 2000).

Establishment of an actual reduction to practice requires a showing of the invention in a physical or tangible form that shows every element of the count. Wetmore v. Quick, 536 F.2d 937, 942, 190 USPQ 223, 227 (CCPA 1976). The device reduced to practice must include every limitation of the count. Fredkin v. Irasek, 397 F.2d 342, 158 USPQ 280, 285 (CCPA 1968); every limitation in a count is material and must be proved to establish an actual reduction to practice. Meitzner v. Corte, 537 F.2d 524, 528, 190 USPQ 407, 410. See also Hull v. Bonis, 214 USPQ 731, 734 (Bd. Pat. Inter. 1982) (no doctrine of equivalents—remedy is a preliminary motion to amend the count to conform to the proofs).

Exhibit A fails to demonstrate that the party constructed an embodiment or performed a process that met ever element. It is unclear if Exhibit A necessarily constitutes proof of a working prototype or if the referenced 'presentation' is simply non-functional demonstration of the intended invention. Exhibit A would also only appear to support the assertion of a 'method' but not the particularly claimed 'system' as there is no reference to the structural components (ex. 'advertisement assembly components') required by the system of claim 1. The limitation common to the independent claims associated with the usage of 'expert rules' such that the 'assembly [is] performed without interaction by said intended audience also does not appear to be shown. The referenced screen-shots (Exhibit A, pages 2-42) are unclear as to how/why the particular media segments are being selected such that 'expert rules' are necessarily being employed or whether or not it is necessarily being 'assembled' without interaction by said intended audience. For example, it is unclear from Exhibit A that the end-user themselves is in fact not entering the profile information and/or subsequently performing the assembly themselves. It is also unclear as to how the limitation of 'providing

said assembled personalized advertisement in a format for delivery' as recited in claims 10 and 13 is evidenced. The referenced pages (Exhibit A, pages 43-44) are almost entirely blacked out, rendering it difficult to conclude what is or is not shown. Finally, the additionally recited counts of claims 3, 5, 6, 7, and 12 do not appear to be evidenced at all other than by an unsubstantiated statement.

As to the second prong of the analysis, the invention must further be recognized and appreciated for a reduction to practice to occur. There is no evidence or showing that the invention was in fact recognized and appreciated.

Response to Arguments

3. Applicant's arguments filed 17 April 2007 have been fully considered but they are not persuasive.

Regarding applicants' declaration to overcome the Ficco reference, as previously set forth, the evidence is considered to be insufficient. Accordingly, the Ficco reference is still applicable to the grounds of rejection.

Regarding applicants' arguments that Ficco fails to select segments based upon the application of expert rules to both user profile data and the advertisement template, the examiner respectfully disagrees. The specification is generally silent as to the nature of 'expert rules' other than to generally set forth that they are used in the selection of various segments. In one embodiment, the system utilizes 'expert rules' in association with the ad selection facture (Para. [0036]) in as far as the 'expert rules' or instructions that the multiplexer [40] employs to select which particular advertisement segment [22-28] to insert

into a particular advertisement slot in light of the particular viewer profile (ex. select segment x over segment y) (Para. [0043]). Furthermore, Ficco teaches that the advertisement selections are selected [30] or targeted using 'data mining' (Para. [0042]). Data mining, as commonly understood in the art, relies upon the creation of 'expert rules' in order to derive patterns and relationships between data. For example, the usage of 'data mining' in the context of Ficco might determine that certain demographic groups that purchase one product (ex. soda) tend to purchase another complimentary product (ex. corn chips). Accordingly, using 'expert rules', a profile indicating that the viewer is a purchaser of one product would result in the particular selection or personalization of an advertisement for another complimentary product (ex. corn chips) since the viewer is likely to purchase the complimentary product based upon the application of expert rules to their profile.

With respect to applicants' argument that Ficco does not assemble a personalized advertisement 'without interaction by said intended audience', the examiner respectfully disagrees. Neither the claim nor the specification assert that absolutely no interaction with the intended audience is involved. Rather, the claim merely requires that the 'assembly' is performed 'without user interaction'. As illustrated in Figure 5, the actual 'assembly' [250/260] by the ad processor [80] is 'without user interaction' per se. Furthermore, it is respectfully noted that the particularly referenced 'user interface' [65] need not even be employed in association with the advertisement assembly (Para. [0026], Lines 4-5 – 'information may be retrieved from the database 60 or from the user interface).

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1 and 3-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Ficco (US Pub No. 2005/0166224 A1).

In consideration of claim 1, Figure 3 illustrates a "system for dynamically constructing a non-interactive personalized advertisement to be viewed by an intended audience". The system comprises a "message campaign" associated with the coordinated effort to provide users with highly individualized broadcast advertisements (Para. [0005]). The 'campaign' includes an "advertisement template" represented by the received generic broadcast advertisement (Para. [0051]). The "advertising template" or generic broadcast advertisement "defines a framework for constructing said personalized advertisement [and the advertising template] comprises a plurality of media segment slots including video segment slots and audio segment slots, wherein at least one video segment slot overlaps at least one audio segment slot" corresponding to the spatial/temporal locations of the audio/video information of the generic broadcast advertisement. The system comprises a "plurality of media segments including video segments and audio segments, each video segment selectable for insertion into at least one of said video segment slots of said for a same one of said video segment slots of said advertisement template, and wherein each audio segment is selectable for insertion into at least one of said audio segment slots of said advertisement template"

(Para. [0028], [0036] – [0038], and [0082] – [0085]). As outlined in the process of Figure 5, the system further comprises an "advertisement assembly component" [30/80] that "responsive to user profile data of said intended audience . . . [is configured to apply] . . [a plurality of] . . . expert rules" associated with targeted advertisement techniques (Para. [0042]) "in order to get appropriate media segments from a database" [20] (Para. [0028], [0029], and [0066]) "and incorporate said appropriate media segments into said advertisement template, in order to assemble said personalized advertisement for said intended audience, said assembly performed without interaction by said intended audience" in so far as to the particular "assembly" simply occurs on-the-fly responsive to the particular display/receipt of a generic broadcast advertisement in a seamless manner (Para. [0053] – [0063]).

Claim 3 is rejected wherein the "said message assembly component also uses . . . temporal information in order to select appropriate media segments for assembling said personalized advertisement" (Para. [0047]).

Claim 4 is rejected wherein the "media segments are selected from the group including audio, video, background, animation, synthesized graphics and voice" (Para. [0061] – [0062]).

Claim 5 is rejected wherein "several of said media segments which corresponds to a same one of said media segment slots of said message template are of different lengths, and said message template appropriately adjusts said personalized advertisement based on a length of a selected one of said media segments" (Para. [0045] – [0047] and [0075]).

Claim 6 is rejected wherein the "personalized advertisement is assembled immediately before presentation to said intended audience" (Para. [0027]).

Claim 7 is rejected wherein "said user profile data of said intended audience is obtained from a plurality of user information data sources" (Para. [0039]).

Claims 8 and 9 are rejected wherein "said advertisement campaign includes a target entity profile . . . providing an indication of appropriate media segments for selected user profile data" and "providing an indication for selecting said intended audience from said user information data sources" (Para. [0042], [0043], [0069], and [0082] – [0087]).

Claim 10 is rejected as previously set forth in the rejection of claim 1. In particular, Figure 5 and its corresponding discussion disclose a "method for dynamically constructing a non-interactive personalized advertisement for viewing by an intended audience". The method involves "obtaining user profile data for said intended audience" [200] and "selecting a message template" associated with the currently received generic broadcast advertisement which "defines a framework for constructing said personalized advertisement and includes a plurality of media segment slots [including video segment slots and audio segment slots wherein at least one video segment slot overlaps at least one audio segment slot which] constitute said personalized advertisement" (Para. [0033] and [0061]). The system subsequently, "applies a plurality of expert rules to said user profile data and said message template, in order to select from a plurality of media segments including video segments and audio segments, appropriate media segments" [210] corresponding to different advertisement segments and/or features "for insertion into said plurality of media segment slots in said message template, wherein several of said video segments are selectable for a same one of

said video segment slots of said message template". The "personalized advertisement" is subsequently "assembled" [250] "using said message template and said selected media segments, without any interaction by said intended audience" and is "provided . . . in a format for delivery to said intended audience for viewing" such that the user simply tunes to a particular channel in order to seamlessly watch the individualized advertisement.

Claim 11 is rejected wherein "said advertising template and plurality of message segments are created as part of an advertising campaign" to provide highly individualized advertisements in order to increase the impact of the advertisement and increase sales volumes (Para. [0008]).

Claim 12 is rejected wherein "said steps of assembling said personalized advertisement and providing said assembled personalized advertisement is performed immediately before delivery to said intended audience" (Para. [0027]).

Claim 13 is rejected as previously set forth in the rejection of claims 1 and 10. In particular, Figure 5 and its corresponding discussion disclose a "method for dynamically constructing a non-interactive personalized advertisement for viewing by an intended audience". The method involves "obtaining user profile data for said intended audience" [200], "creating a plurality of media segments, including video segments and audio segments" [300] corresponding to distributed advertisement segments, "creating a message template" associated with the generic broadcast advertisement which "defines a framework for constructing said personalized advertisement and includes a plurality of media segment slots [including video segment slots and audio segment slots wherein at least one video segment slot overlaps at least one audio segment slot which] constituting said personalized

advertisement" (Para. [0033] and [0061]). The system subsequently, "applies a plurality of expert rules to said user profile data and said message template, in order to select from a plurality of media segments including video segments and audio segments, appropriate media segments for insertion into said plurality of media segment slots in said message template, wherein several of said video segments are selectable for a same one of said video segment slots of said message template" [210]. For example, several of the particular segments could have selected for display during the display period depending upon the user. The "personalized advertisement" is subsequently "assembled" [250] "using said message template and said selected media segments, without any interaction by said intended audience" and is "provided . . . in a format for delivery to said intended audience for viewing" such that the user simply tunes to a particular channel in order to seamlessly watch the individualized advertisement.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- The Kleinberg et al. (US Pat No. 5,884,305) reference provides evidence that it is commonly known that data mining involves the usage of expert rules to derive relationships between data for advertisement targeting.

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry

under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Beliveau whose telephone number is 571-272-7343. The examiner can normally be reached on Monday-Friday from 8:30 a.m. - 6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information

about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Scott Beliveau
Primary Examiner
Art Unit 2623

SEB
May 7, 2007